

REMARKS

Reconsideration of the application as amended is respectfully requested in view of the comments below. The Examiner's objections and rejections are addressed in substantially the same order as in the referenced office action.

Claims 1-40 are pending in this application. Claims 1, 15, 21, and 28 are independent claims. The remaining claims depend, directly or indirectly, from claims 1, 15, 21, and 28. Claims 1, 15 and 21 have been amended to include the ability of multiple users using different programs for different tasks to update each other in a near real time environment. References to immediate access are found, for example, at **page 13, line 21, page 30 lines 12-21, page 31 line 8**. Additional support for this amendment is found for example at **page 20 line 16-page 21 line 5**.

II. Rejection(s) under 35 U.S.C § 103

Claims 1-7 and 15-27 stand rejected under 35 U.S.C. § 103 over U.S Patent No. 5,893,079 issued to *Cwenar* in view of U.S. Patent No. 5,475,589 issued to *Armitage*.

The present invention defined in claim 1 recites "a data repository storing related hydrocarbon-producing portfolio data tied to a key parameter field." Claim 1 further recites "at least one application server to provide a plurality of different applications to a plurality of users." At least one of the plurality of the different applications generates "at least some related *hydrocarbon-producing portfolio data* having the key parameter field, wherein the data repository can be updated with the related *hydrocarbon-producing*

portfolio data generated by each of the plurality of different applications.”

Cwenar discloses a data management system that compiles data from outside non-user sources into a database that is accessible through a user interface. The database functions include storing, retrieving, and manipulating data (column 5, lines 22-26). The system disclosed by *Cwenar* is particularly relevant to investment data, which is the focus in the description, because financial data is similar in format. Data enter the database from external *non-user* sources (Figure 1, column 4, lines 51-65).

The database in *Cwenar* is updated by the external sources, and not by users and a plurality of different programs, as recited in the claims. *Cwenar* is clear in only allowing outside non-user sources to provide new data and update old data stored in the database (Figure 1, column 4, lines 51-65). Exporting data to user programs is accomplished through the user interface (column 7, lines 21-35). This is not equivalent to “updating any of the stored hydrocarbon-producing portfolio data having the key parameter field when ones of the plurality of applications modify any of the stored hydrocarbon-producing portfolio data having the key parameter field,” as recited in independent claims 1.

Independent claim 1 as amended also include allowing multiple users using different programs for different tasks to update each other in a near real time environment. There is no teaching or suggestion in *Cwenar* of this, and *Cwenar* does not accomplish this by merely providing data export functions to users.

In order to sustain a rejection under 35 USC § 103, two requirements must be

met. First, all the limitations of the claimed invention must be disclosed in the prior art. Secondly, if the first requirement is met, there must be a teaching or suggestion in the prior art to combine the references to come up with the claimed invention, or, a motivation to combine the references. The first requirement is clearly not satisfied here as neither *Cwenar* nor *Armitage* disclose allowing multiple users using different programs for different tasks to update each other in a near real time environment. Accordingly, applicant respectfully submits that claim 1 and claims 2-14 that depend upon claim 1 are patentable under 35 USC § 103 over *Cwenar* in view of *Armitage*.

Independent claims 15 and 21 include the substantive limitation of claim 1 discussed above. Accordingly, applicant further submits that claims 15 (and dependent claims 16-20) and claim 21 (and dependent claims 22-27) are patentable under 35 USC § 103 over *Cwenar* in view of *Armitage*.

Claims 8-11 stand rejected under 35 USC §103 over *Cwenar* in view of *Armitage* and *Dembo*. This has already been addressed above in the rejection of claim 1 over *Cwenar* in view of *Armitage*. Applicant notes that *Dembo* fails to disclose the limitation of claim 1 discussed above, i.e., allowing multiple users using different programs for different tasks to update each other in a near real time environment.

Claim 12 stands rejected under 35 U.S.C. § 103 as obvious over *Cwenar* in view of *Armitage*, and further in view of U.S. Patent No. 6,484,151 B1 issued to *O'Shaughnessy*. This has already been addressed above in the rejection of claim 1 over

Cwenar in view of *Armitage*. Applicant notes that *O'Shaughnessy* fails to disclose the limitation of claim 1 discussed above, i.e., allowing multiple users using different programs for different tasks to update each other in a near real time environment.

Claims 13 and 14 stand rejected under 35 U.S.C. § 103 as obvious over *Cwenar* in view of *Armitage*, and further in view of U.S. Patent No. 6,373,489 B1 issued to *Lu* et al. This has already been addressed above in the rejection of claim 1 over *Cwenar* in view of *Armitage*. Applicant notes that *Lu* fails to disclose the limitation of claim 1 discussed above, i.e., allowing multiple users using different programs for different tasks to update each other in a near real time environment.

Claims 28-40 stand rejected under 35 U.S.C. § 103 as obvious over *Lu* in view of *Armitage*.

With respect to independent claim 28, applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness. As a general note on the *Lu* and *Armitage* references, both references apply to specific programs used individually without reference to team members, or updating corresponding data *automatically* in other applications based on data generated using at least one other application. None of the cited portions by the Examiner have indicated otherwise. In particular, the Examiner cited *Lu* as disclosing “that the notifying at least one of the asset team members that corresponding data used by one of the applications used by the at least one asset team member have been updated by the operation of the other one of the

applications used by at least one other asset team member (citing column 6, lines 16-18, and column 25, lines 34-37, *Lu*).” The cited portion of column 6 merely discloses incrementally updating the particular model. This occurs within a single program by a single user. The cited portion of column 25 merely discloses updating another modeling tool (SIGMA) automatically with the models generated by the invention disclosed by *Lu*. Thus, *Lu* does not show or suggest team members using another program being automatically updated by the work performed by another team member using another program.

The Applicant respectfully notes that the Examiner has provided no acknowledgement of the Applicant’s arguments in the previous response concerning the combination of *Lu* in view of *Armitage*. The Applicant requests that the Examiner respond to the previous arguments which are repeated below with minor modifications

Of claims 28-40, claim 28 is independent. Claims 29-40 depend either directly or indirectly from claim 28. Claim 28 recites a method for managing a hydrocarbon-producing portfolio. The method comprises a plurality of asset members with varying roles using a variety of different applications corresponding to their respective roles. The possible asset team members include a geoscientist, a landman, a reservoir engineer, a regulatory compliance administrator, a right-of-way administrator, a drilling engineer, a completion engineer, a finance analyst, a field operator, a sales and marketing representative, and a portfolio manager. The corresponding data from any given application used by the various asset team members can be automatically updated and can be used by the other applications.

In contrast, *Lu* discloses a method for building and visualizing geometry models.

The visualization is meant to be particularly suited for modeling in the geosciences. The Examiner asserts that *Lu* discloses a plurality of asset team members comprising geologists, geophysicists, and petroleum engineers (col. 1, lines 14-21). The Applicant respectfully disagrees. The cited text is merely claiming that the visualization method of the invention would have value to geologists and geophysicists (collectively considered to be geoscientists), and petroleum engineers. *Lu* is silent on those people being team members in any form. *Lu* does not teach that the petroleum engineer has any input to the database that is the subject of the present invention. Additionally, *Lu* does not mention team members outside of the geosciences such as a regulatory compliance administrator, a right-of-way administrator, a finance analyst, or a sales and marketing representative.

Further, *Lu* **does not disclose separate applications** employed by team members with various roles. *Lu* only discloses **a single visualization tool** that may be useful for those in the geosciences. Further, *Lu* does not disclose any data corresponding to other applications being generated. Instead, *Lu* only speaks of the single visualization model generated by the method disclosed in *Lu*.

Armitage fails to provide that which *Lu* lacks with respect to the invention of claim 28. Thus, claim 28 is patentable over *Lu* and *Armitage*. Claims 29-40, which depend on claim 28, are allowable for at least the same reasons. Accordingly, applicant respectfully submits that claim 28 and claims 29-40 that depend upon claim 28 are patentable under 35 USC § 103 over *Lu* in view of *Armitage*.

For the sake of argument, even if all the limitations of claim 28 are disclosed in the combination of *Lu* and *Armitage* (which they are not), a second requirement to sustain a rejection under 35 USC § 103 has not been met. As noted above, in order to sustain a rejection under 35 USC§ 103, the prior art must teach all the elements of the claimed invention. In addition, there is a requirement that there should be a teaching or suggestion in the prior art for such a combination.

"The factual inquiry whether to combine references must be thorough and searching." It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed

invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references"). *In re Lee*, 61 U.S.P.Q.2D 1430, (Fed. Circuit, 2002).

In the absence of a specific teaching or suggestion to combine the reference, a later court has held that

Even if all its limitations could be found in the total set of elements contained in the prior art references, a claimed invention would not be obvious without a demonstration of the existence of a motivation to combine those references at the time of the invention. See *Ecolochem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000). This requirement prevents a court from labeling as obvious in hindsight a solution that was not obvious to one of ordinary skill at the time of the invention. See *id.*

The district court held that "at the time the '575 patent was invented, there was no suggestion, teaching, or motivation to combine Udstad with Wagner." We disagree. CPR relied primarily on two sources pre-dating the application for the '575 patent to demonstrate the requisite motivation to combine: the "Lund drawing" and the "Prichard disclosure." Although the district court discussed both, the district court's focus seems to have centered on whether either had been

disseminated to a sufficiently broad public so as to give either the status of a prior art reference. Yet, the prior-art status of the Prichard disclosure and the Lund drawing is not dispositive. [the] motivation to combine need not be found in prior art references, but equally can be found "in the knowledge generally available to one of ordinary skill in the art." (citing) In re Jones, 958 F.2d 347, 351 (Fed. Cir. 1992)

National Steel Car. Ltd. vs. Canadian Pacific Railway Ltd., 69 U.S.P.Q.2D (BNA) 1641, (Fed. Cir. 2004, rehearing denied, rehearing denied en banc).

The case cited in *National Steel*, i.e., *In re Jones*, specifically held that:
"Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art....
... Conspicuously missing from this record is any *evidence*, other than the PTO's speculation (if it be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modifications of the prior art salts necessary to arrive at the claimed 2-(2'-aminoethoxy)ethanol salt." *In re Jones*, 21 U.S.P.Q.2D 1941 (Fed. Circuit, 1992)

We note that the *National Steel Car* 2004 case did not overrule or even discuss the 2002 *Lee* case, and that the basic opinion was that of a court panel: only a rehearing was denied *en banc*.

A check in the amount of \$1220 is enclosed. This covers the fee of \$430 under 37 CFR § 1.36(a) for a two month extension, and a fee of \$790 for the Request for Continued Examination. The Commissioner is authorized to charge any deficiencies and credit any surplus to deposit account 13-0010 (CON-1028).

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Respectfully submitted,



Kaushik P. Sriram, Reg. No. 43,150
Madan, Mossman & Sriram, P.C.
2603 Augusta Suite 700
Houston, Texas 77057-5638
Tel: (713) 266-1130 x 121
Fax: (713) 266-8510
Attorney For Applicants